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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FLOOD, MICHELE C

ART UNIT PAPER NUMBER

1651

DATE MAILED: 04/09/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,800

Applicant(s)

CANNELL et al.

Examiner

Michele Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 19, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17 20) ☐ Other:

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DETAILED ACTION

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 19, 2002 has been entered.

Claims 1-13 are under examination.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Information Disclosure Statement

The information disclosure statement filed January 23, 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

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Although Applicant urges on page 2 of Paper No. 7 entitled INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(c) "In lieu of a statement of relevance or translation of the non-English documents, an English language version of a search report from the European Patent Office in a corresponding application citing these documents and setting forth the relevance thereof is enclosed," no such document explaining the relevance of the non-English documents were found in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 and 10-12 remain/are rejected under 35 U.S.C. 102(b) as being anticipated by Ruiseco (A), Greff (FR 2740331 A1), and Leip (B). The claims remain rejected for the reasons set forth in the previous Office action and set forth below.

Applicant argues that Ruiseco does not teach protection of keratinous fiber from extrinsic damage according to the present invention, wherein extrinsic damage is damage to keratinous fiber "that is caused by conditions such as sun, chemical damage, e.g., from detergents,

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bleaching, relaxing, dyeing, and permanent waving, and heat, e.g., from hair dryers or curlers.”

Applicant further argues that Ruiseco, unlike the claimed invention, teaches a method for the treatment of hair loss in a patient undergoing treatment for angina or radiation therapy, which constitutes a “treatment for intrinsic damage, i.e., damage to hair follicles.” Thus, Applicant concludes that Ruiseco does not identically describe the invention according to the instantly claimed subject matter. However, Applicant’s arguments are not persuasive because in Column 3, lines 45-49, Ruiseco teaches directly applying a hair treatment composition comprising avocado extract to hair, and “leaving the composition on the hair overnight.” The composition is effective in treating hair in patients undergoing chemotherapy for cancer and radiation used in cancer therapy (see Column 2, lines 10-17 and Column 4, lines 14-17). In Column 3, lines 58-60 bridging Column 4, lines 1-2, Ruiseco teaches “It has been found that this treatment of hair of cancer patients undergoing radiation treatment prevents the drying out of the hair and concurrent loss of oils which is otherwise produced by this type of cancer treatment therapy.” As radiation therapy is a form of heat, which causes damage to the hair of cancer patients undergoing radiation chemotherapy, a method of protecting keratinous fiber (hair) from extrinsic damage comprising applying to keratinous fiber a composition comprising avocado is taught by Ruiseco because Applicant’s definition of extrinsic damage encompasses the term heat.

Greff teaches a composition comprising extracts of *Solanum tuberosum* L. or potato extract and hydrolysate of wheat protein for the treatment and care of hair from extrinsic damages, i.e., sun protection of hair and protecting against pollution and attack. The amount of

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the plant extracts used in the formulation of the referenced composition is an amount of 0.0001 and 0.01% (see page 8, lines 11-12).

Leip teaches a method of applying to the hair a composition comprising potato extract, wherein a pound of potatoes are used in the making of the referenced hair tonic. Leip does not expressly teach applying the hair tonic as a method of protecting keratinous damage from extrinsic damage. However, the instantly claimed process is a one-step process of applying to keratinous fiber an extract of potato. Thus, the functional effect of protecting keratinous fiber from extrinsic damage is inherent to the method of using the composition taught by Leip.

The references anticipate the claimed subject matter.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Product Alert (U).

Product Alert teaches "Technician Conditioner" comprising avocado extract. "This rich, intensive conditioner helps repair dry, damaged, chemically-treated, and over-processed hair." The reference anticipates the claimed subject matter.

Claims 1-3 and 10-11 rejected under 35 U.S.C. 102(b) as being anticipated by JP 01190622 (N) and Salinas (D).

JP 01190622 teaches a shampoo or treatment composition comprising avocado oil and one or more polysaccharides, which is used to recover damaged hair and to protect the hair. The

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method of using the referenced composition is not expressly taught as a method of protecting keratinous damage from extrinsic damage. However, the instantly claimed process is a one-step process of applying to keratinous fiber an extract of avocado comprising at least one sugar, wherein the sugar is a polysaccharide. Thus, the functional effect of protecting keratinous fiber from extrinsic damage is inherent to the method of using the composition taught by JP 01190622.

Salinas teaches a method of applying to the hair a composition an extract of potato and lantana. In Column 2, line 57, Salinas teaches that lantana leaves contain reduced sugars. The method of using the referenced composition is not expressly taught as a method of protecting keratinous damage from extrinsic damage. However, the instantly claimed process is a one-step process of applying to keratinous fiber an extract of ^{potato}~~avocado~~ comprising at least one sugar. Thus, the functional effect of protecting keratinous fiber from extrinsic damage is inherent to the method of using the composition taught by Salinas.

The references anticipate the claimed subject matter.

Claims 1-4, 6-7 and 10-13 remain rejected under 35 U.S.C. 102(e) as being anticipated by Carson et al. (E). The claims remain rejected for the reasons set forth in the previous Office action and set forth below.

Applicant argues that Carson does not identically describe or disclose the instantly claimed invention because Carson discloses plant essential oils such avocado oils, instead of plant extracts as instantly claimed. Applicant further asserts that "Essential oils are not plant

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extracts according to the present invention. See e.g., International Cosmetic Ingredient Dictionary and Handbook, Eight Edition, Vol. 2, Section 3, 2000 (classifying into chemical classes plant extracts as “Biological Products” at p. 1646 and essential oils as “Essential Oils” at p. 1669).” However, this is not persuasive because neither does Applicant’s specification exclude plant essential oils as plant extracts nor does Applicant provide a copy of the aforementioned document such that an evaluation of Applicant’s assertion be made. Accordingly, Carson teaches a method of delivering a compositions for topical application to mammalian skin, hair or nails containing sugars (wherein the sugar moiety is either a monosaccharide, disaccharide or a polysaccharide) and at least one plant extract. Suitable oils or lipophilic compounds taught by Carson include avocado oil. In Column 9, lines 36-54, Carson teaches that the amount of the lipophilic compound in the composition ranges from 0.01% to 10% by weight, preferably from about 0.1% to 3%. The reference anticipates the claimed subject matter.

Claims 1-3 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah (EP 0681826A2).

Shah teaches a method of protecting keratinous fiber comprising applying to hair a shampoo composition comprising wheat oligosaccharides and wheat germ extract (hydrolyzed wheat protein and wheat amino acids). See Table 1. Shah further teaches that the application of the referenced composition protects chemically damaged hair, bleached hair, and permed hair.

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The hydrolyzed wheat protein and wheat oligosaccharides generally comprise from about 2.5% to about 5% (W/W) of the total formulation while the wheat amino acids comprise from about 0.2 to about 1% (W/W). See page 4, lines 23-26. The reference anticipates the claimed subject matter.

Claims 1-3 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf et al. (C).

Wolf teaches a method of applying to the hair and nails compositions comprising extensin protein extracted from potatoes and wheat, wherein the amount of the plant extracts comprising the cosmetics is about 0.001-30% or 0.1-10% or 0.5-5%. See Column 3, lines 40-61. In Column 2, lines 13-16, Wolf teaches that extensins comprise sugars. The extensins are incorporated into the making of hair shampoos or conditioners, and nail enamels (see Column 4, lines 27-48). The method of using the referenced composition is not expressly taught as a method of protecting keratinous damage from extrinsic damage. However, the instantly claimed process is a one-step process of applying to keratinous fiber a composition comprising potato extract or wheat germ extract and at least one sugar, wherein the sugar is a polysaccharide. Thus, the functional effect of protecting keratinous fiber from extrinsic damage is inherent to the method of using the composition taught by Wolf.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 10-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sakai (O).

Sakai teaches a hair tonic comprising a potato (yam) extract consisting essentially of saccharide and protein of natural yam, which has excellent moisture retaining effects. Sakai does not expressly teach applying the hair tonic composition to the hair; however, Sakai clearly teaches his composition as a hair tonic. Thus, the referenced composition is clearly envisaged to be used as a hair tonic wherein the composition is applied to the hair. As the instantly claimed process is a one-step process of applying to keratinous fiber an extract of potato comprising at least one sugar, the claimed functional effect of protecting keratinous fiber from extrinsic damage is inherent to the method of using the composition taught by Sakai.

The claims are drawn to a method of protecting keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract and further comprising at least one sugar.

The cited reference discloses a hair tonic comprising a potato (yam) extract consisting essentially of saccharide and protein of natural yam ---- which appears to be identical to the

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presently claimed composition and method of using thereof, since it exhibits beneficial moisturizing effects and its envisaged intended use is directed to application to hair since it is a hair tonic. Therefore, the cited reference is considered to anticipate the claimed method of protecting keratinous fiber from extrinsic damage comprising applying to keratinous fiber a composition comprising potato extract and at least one sugar.

In the alternative, even if the claimed method of using the disclosed composition is not identical to the referenced extract with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced extract preparation is likely to inherently possess the same characteristics of the claimed extract preparation particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed method of using the disclosed composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

The United States Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not Applicants' strain differs and, if so, to what extent, from that discussed in the references. Therefore, with the showing of the references, the burden of establishing non-obviousness by objective evidence is shifted to Applicants.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

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Claims 1 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Konishi et al. (P) and Lekim (Q).

Konishi teaches a hair tonic comprising an extract of mistletoe in an amount 0.1-5%.

Lekim teaches a hair tonic comprising an extract of mistletoe in an amount as instantly claimed (see Column 2). Neither Konishi nor Lekim expressly teach applying the hair tonic composition to the hair; however, both Konishi and Lekim clearly teach the referenced compositions as a hair tonic. Thus, the referenced compositions are clearly envisaged to be used as a hair tonic wherein the composition is applied to the hair. As the instantly claimed process is a one-step process of applying to keratinous fiber an extract of mistletoe, the claimed functional effect of protecting keratinous fiber from extrinsic damage is inherent to the method of using the compositions taught by Konishi and Lekim.

The claims are drawn to a method of protecting keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising mistletoe extract.

The cited references disclose a hair tonic comprising mistletoe extract --- which appears to be identical to the presently claimed composition and method of using thereof, since they exhibit beneficial effects to the hair, and their envisaged intended use is directed to application to hair as they are hair tonics. Therefore, the cited references are considered to anticipate the claimed method of protecting keratinous fiber from extrinsic damage comprising applying to keratinous fiber a composition comprising a mistletoe extract.

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In the alternative, even if the claimed method of using the disclosed composition is not identical to the referenced extract with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced extract preparation is likely to inherently possess the same characteristics of the claimed extract preparation particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed method of using the disclosed composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

The United States Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not Applicants' strain differs and, if so, to what extent, from that discussed in the references. Therefore, with the showing of the references, the burden of establishing non-obviousness by objective evidence is shifted to Applicants.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiseco (A), Greff (FR 2740331 A1), Leip (B), Product Alert (U), Yamagata (N) and Salinas (D), Carson et al. (E), Shah (EP 0681826A2), Wolf et al. (C), Sakai (O), Konishi et al. (P) and Lekim (Q) in view of Pineau et al. (F).

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The teachings of Ruiseco, Greff, Leip, Product Alert, Yamagata, Salinas, Carson, Shah, Wolf, Sakai, Konishi and Lekim are set forth above. None of the references teach a method of protecting keratinous fiber from extrinsic damage comprising applying to keratinous fiber at least one extract chosen from the Markush group of Claim 1, wherein the composition further comprises monosaccharides chosen from pentoses and hexoses; pentoses chosen from ribose, arabinose, xylose, lyxose, ribulose and xylulose; hexoses chosen from allose, altrose, glucose, mannose, gulose, idose, galactose, talose, sorbose, psicose, fructose, and tagatose; disaccharides chosen from maltose, sucrose, cellobiose, trehalose and lactose; and polysaccharides chosen from starches, dextrans, celluloses and glycogens. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the instantly claimed sugars to the compositions taught by Ruiseco, Greff, Leip, Product Alert, Yamagata, Salinas, Carson, Shah, Wolf, Sakai, Konishi and Lekim in the formulation of a composition which used in a method of protecting keratinous fiber from extrinsic damage because Pineau teaches a composition comprising heterogenous polyholosides comprising 2 to 10 oses or monosaccharides. Pineau teaches the referenced compositions as active agents to combat extrinsic aging which can be used in the formulation of topically applied cosmetics for the hair. See Column 3, lines 43-67 to Column 4, lines 1-64. At the time the invention was made, one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to add the sugars taught by Pineau to the compositions taught by Ruiseco, Greff, Leip, Product Alert, Yamagata, Salinas, Carson, Shah, Wolf, Sakai, Konishi and Lekim in

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the formulation of a composition which is used in a method of protecting keratinous fiber from extrinsic damage because Pineau teaches that the sugar composition protects keratinous fiber from extrinsic damage.

Moreover, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add any of the claimed ingredients in the making of the claimed compositions for use in the claimed method of use because it is well known that its *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Pinten*, 459 F. 2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, at the time the invention was one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to add any of the claimed ingredients taught by Pineau to any of the ingredients taught by Ruiseco, Greff, Leip, Product Alert, Yamagata, Salinas, Carson, Shah, Wolf, Sakai, Konishi and Lekim to provide the claimed method because the claimed invention is no more than the combining of well known ingredients used in well known methods for protecting keratinous fiber from extrinsic damage.

As each of the references indicate that the various proportions and amounts of the ingredients used in the claimed composition or the claimed composition combinations are result

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variables, they would have been routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by each of the references.

Accordingly, the claimed invention was prima facie obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/527,599. The rejection stands for the reasons set forth in the previous Office action and repeated below, as Applicant traverses the rejection without setting forth any substantial reasons for the traversal of the rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to the use of identical or at least very similar ingredients

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to effect the same result or essentially the same result. Thus, the claims are obvious variants of each other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. The examiner can normally be reached on Monday through Friday from 7:15 am to 3:45 pm. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Michael Wityshyn whose telephone number is (703) 308-4743.

MCF

April 3, 2002



CHRISTOPHER R. TATE
PRIMARY EXAMINER